

U.S. Patent Application Serial No. 09/768,178
Amendment filed December 9, 2004
Reply to OA dated September 22, 2004

REMARKS

Claims 11-29 are pending in this application. Claim 10 has been canceled without prejudice or disclaimer, and claims 11, 13, 17 and 26 have been amended in order to more particularly point out, and distinctly claim the subject matter to which the applicant regards as his invention. The applicant respectfully submits that no new matter has been added. It is believed that this Amendment is fully responsive to the Office Action dated **September 22, 2004**.

The amendment to claim 11 is for clarity, amending “an optical medium” to –said optical medium– in line 6 of the claim, with antecedent basis to “an optical recording medium” in line 2 of the claim. The amendments to claims 13 and 17 delete the dependency from canceled claim 10. The amendment to claim 26 corrects the dependency of this claim, to depend from claim 22.

Claims 10-19, 23, 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 5,573,831). (Office action paragraph no. 3)

The rejection of claim 10 is moot in view of the cancellation of claim 10 without prejudice or disclaimer. The dependence of claims 13 and 17 from claim 10 has been deleted. The rejection of claims 11-19, 23, 25, and 29, is respectfully traversed.

The Examiner cites Suzuki et al. for disclosing an optical recording medium including a protective layer, where the protective layer is formed of an ultraviolet curable resin. With regard to the pH parameter limitation in the claims, the Examiner states that “Suzuki does not show that the ultraviolet composition has a pH value. However such pH is a property which can be easily

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determined ...” The Examiner is, of course, correct that some value of pH for a solution would be inherent for any composition. The Examiner then states:

“... absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine modification. The experimental modification of prior art in order to optimize operation conditions (e.g. pH) fails to render the claims patentable in the absence of unexpected results.”

Applicant respectfully disagrees, and argues that this does not provide a proper motivation for modifying the reference as a basis for a *prima facie* case of obviousness. The Examiner is stating as a motivation for modifying the reference, that the adjustment of pH is “routine modification.” However, the Examiner has admitted that the pH parameter recited in the claims is **not even mentioned** in Suzuki. Therefore, Suzuki **cannot be suggesting any modification of this parameter.**

Moreover, the Examiner refers to “[optimizing] operation conditions.” However, the Examiner does not state **which result parameter is being optimized** by the adjustment of pH, and again there is no suggestion in Suzuki et al. for such an optimization.

Further, it is clear that modification of the recited “pH of a 1.0% methanol solution” parameter can only be achieved by **modification of the chemical nature of the polymerizable composition.** This general principle is stated on page 10, line 15 and ff. of the specification, where it is pointed out, in effect, that a balance between acidic and basic monomers, oligomers and initiators must be achieved. The Examiner has not pointed out where Suzuki suggests such a compositional modification, and Applicant argues that Suzuki does not suggest this.

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Applicant notes that the argument that Applicant has previously argued along these lines in the Amendment of January 22, 2004, on page 11, third paragraph. Applicant further notes that the Declaration under 37 CFR 1.132 filed on January 22, 2004, provides data indicating that Example 2 of Suzuki inherently has a value of the pH parameter of 8.2, outside the range in the present claims. Likewise, the resin SD-17, appearing in Examples 3-5, has a pH parameter value of 3.8, again outside the range in the claims.

Applicant also notes, with regard to claims 11 and 12, that these claims require Ag in a reflective film next to the protective film. The Examiner cites Suzuki in column 3, line 67, to column 4, line 1, as disclosing Ag, but Ag is only one of five metals listed, with Au being preferable. Moreover, Suzuki indicates that Au is preferable because the other metals are reactive and affected by oxygen and water (column 4, lines 1-5).

Applicant respectfully notes that the Examiner has directed comments to claims 5 and 9 (page 3 of the Office action, lines 12-20), although these claims were not pending. Applicant has not addressed these comments.

Applicant further notes that claim 13 recites a specific limitation on the concentration of monomer or oligomer having a carboxyl group. The Examiner does not appear to have addressed this limitation. In Suzuki, the hydrophilic polymer is dissolved in a polar hydrophilic monomer

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(column 6, line 6), which may be one of the listed monomers in column 6, and in particular may be a “monomer having a group of high polarity, such as a hydroxyl group, a carboxyl group, and an amino group” (column 6, line 44). Suzuki indicates that “The total amount of the hydrophilic monomer is in the range of from 20 to 98 parts by weight, and preferably from 50 to 90 parts by weight based on the resin composition” (column 6, lines 51-54). Therefore, it would appear that if a carboxyl group-containing monomer is present in Suzuki, it would be present at **at least 20%**. This is inconsistent with the recitation of claim 13, and of dependent claim 23.

Applicant therefore submits that pending claims 11-19, 23, 25, and 29, are novel and non-obvious over Suzuki et al. (U.S. 5,573,831).

Claims 20-22, 24 and 26-28 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Office action paragraph no. 4)

Reconsideration of the objection is respectfully requested. Since Applicant has traversed the rejection of the base claims over Suzuki et al., Applicant has not rewritten claims 20-22, 24 and 26-28 in independent form. Applicant notes that claim 26 has been corrected to depend from claim 22.

In view of the aforementioned amendments and accompanying remarks, claims 11-29, as amended, are in condition for allowance, which action, at an early date, is requested.

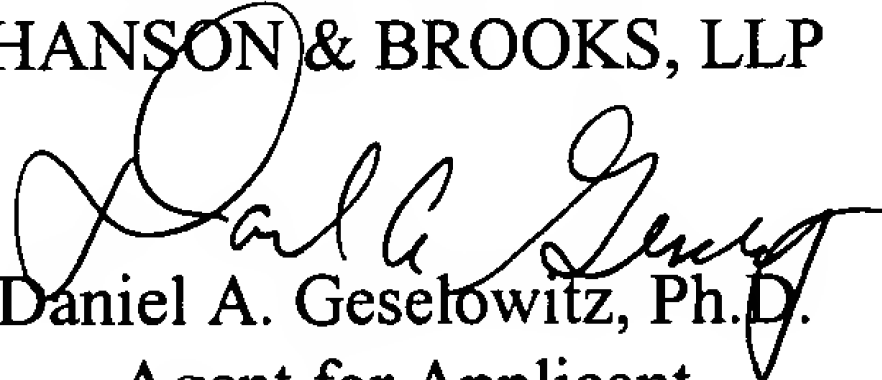
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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

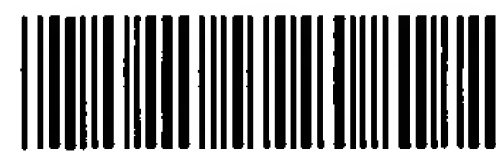
Respectfully submitted,

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